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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,459	08/02/2007	Peter Habermeyer	635.46315X00	4231
20457 7590 12/12/2007 ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-3873			EXAMINER STEWART, JASON-DENNIS NEILKEN	
			ART UNIT 3738	PAPER NUMBER
			MAIL DATE 12/12/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/586,459

Applicant(s)

HABERMEYER ET AL.

Examiner

Jason-Dennis Stewart

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3-8 and 10-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8 and 10-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date See Continuation Sheet.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :18 July 2006, 18 October 2006, 28 November 2006.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 4-7, 12, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Tornier 2003/0149485.

3. Regarding Claims 1 and 16, Tornier illustrates at least a two-piece humeral prosthesis with a joint head 1 and attachment part 2 with a disk-like portion having a medial hole 25 (fig. 1). The phrase “to effect an at least cement-free anchoring attachment” is seen as an intended use limitation being that all structure is present in the prior art invention.

4. Regarding Claims 4 and 12, Tornier illustrates a joint head with a nearly spherical surface and an opening with an angle alpha less than 180 degrees (Fig. 1).

5. Regarding Claim 5, Tornier illustrates a circular support surface 23 with a conical support edge that rests on support edge (fig. 5).

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6. Regarding Claim 6, Tornier illustrates a hollow receiver 11 on the side opposite the nearly spherical surface (fig. 1).

7. Regarding Claim 7, Tornier illustrates a slightly conical receiver wall 12 and a slightly conical external collar surface 24 (fig. 3).

8. Claims 8 rejected under 35 U.S.C. 102(e) as being anticipated by Guederian et al. 2004/0059424.

9. Regarding Claim 8, Guederian discloses a method of fitting a shoulder prosthesis comprising fitting the attachment part on previously prepared bone with the use of projections 209 and 214, after which anchoring body is affixed to the bone by hollow screw 8 through a medial hole 206 in the positioning body (paragraphs 15 – 20).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3, 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tornier 2003/0149485 in view of Guederian et al. 2004/0059424.

12. Regarding Claims 3 and 14, Tornier discloses the invention as claimed and as discussed above. However, Tornier does not disclose a hollow screw.

Guederian discloses a hollow screw 8 to provide primary fixation of a glenoid component to bone.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the prosthesis of Tornier with the hollow screw of Guederian in order to provide bone growth into the screw as taught by Guederian (paragraph 19).

13. Regarding Claim 13, Tornier illustrates a circular support surface 23 with a conical support edge that rests on support edge (fig. 5).

14. Regarding Claim 15, Tornier illustrates a joint head with a nearly spherical surface and an opening with an angle  $\alpha$  less than 180 degrees (Fig. 1).

15. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guederian et al. 2004/0059424 in view of Tornier 2003/0149485.

16. Regarding Claims 10 and 11, Guederian discloses the invention as claimed and as discussed above. However, Guederian does not disclose a hollow receiver with a slightly conically shaped wall, a collar with a slightly conically shaped edge, and an external force used to fix the attachment body.

Tornier discloses Tornier illustrates a slightly conical receiver wall 12 and a slightly conical external collar surface 24 (fig. 3) for the purpose of mating the joint head and the anchoring means as well as a force (E1) used to fix the parts of the prosthesis together.

It would have been obvious one of ordinary skill in the art at the time of the invention to modify the method of Guederian with the steps of Tornier in order to securely fix the femoral head to the anchoring means during surgery.

**Conclusion**


17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure, as per the Notice of References Cited.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason-Dennis Stewart whose telephone number is (571)270-3080. The examiner can normally be reached on M-F (alt Fridays off) 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571)272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JS

  
12/17/07

  
BRIAN E. PELLEGRINO  
PRIMARY EXAMINER